

2. At page 1, line 9, replace "DRA-3426, filed ____" with -08/789,024, filed January 27, 1997-.

3. At page 1, line 12, replace "DRA-3424, filed ____" with -08/789,027, filed January 27, 1997-.

4. At page 1, lines 14- 15, replace "DRA-3423 filed ____" with -08/789,028, filed January 27, 1997-.

5. At page 1, line 18, replace "DRA-3430, filed ____" with -08/789,029, filed January 27, 1997-.

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner (i.e. Paper No. 3¹) mailed February 23, 2000. Having addressed all objections and grounds of rejection, claims 1-41, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

¹This Official Action should probably have been designated Paper No. 5, as Paper No. 4 was mailed September 22, 1998. However, to be consistent with the actual designation made by the Examiner, the Official Action mailed February 23, 2000 will be herein referred to as Paper No. 3.

The above amendments to the specification address certain informalities. Specifically, missing serial number and filing date information has been supplied for cross-referenced applications.

The Examiner has surprisingly found all 41 originally presented claims to be anticipated by U.S. Patent No. 5,726,903, issued to Nishiyama. In making this blanket rejection, the Examiner simply states:

Claims 1-41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Nishiyama (U.S. Pat. No. 5,550,714). See Figs. 1 and 6 of Nishiyama.

This rejection is respectfully traversed as being procedurally and legally inadequate and clearly erroneous factually.

"It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention, and that such a determination is one of fact." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 90 (Fed. Cir. 1986). Claim 1 is a method claim limited by a "generating" step, a "selecting" step, and an "establishing" step. The Examiner doesn't even allege that Nishiyama has the combination of these three steps. Therefore, the Examiner has not even attempted to comply with the law with respect to claim 1. Thus, the rejection of claim 1 is respectfully traversed as failing to meet the

minimum legal or procedural requirements to establish anticipation.

The Examiner is also clearly erroneous factually. This is easily seen, as the present invention is concerned with providing a human user with the tools for viewing and visually manipulating elements of an automated design database (see page 2, lines 3-7). All of the claims, including claim 1, are limited to method steps and apparatus involving display and manipulation of the design database.

Nishiyama, on the other hand, proposes a system for automatically drawing net diagrams. It appears that user manipulation of design database elements is of no more than incidental concern to Nishiyama. In citing Figs. 1 and 6, the Examiner further confuses the matter. Nishiyama describes Fig 1 as:

FIG. 1 is a schematic configuration diagram of a schematic generator of (sic) automatically producing a logic circuit diagram.....

Fig. 6 is simply a flowchart. Therefore, to the extent that the Examiner suggests that the claim elements are found in Nishiyama, these fact findings are clearly erroneous.

The remaining claims (i.e., claims 2-41) present additional limitations which are addressed in neither the Official Action (i.e., paper 3) nor the cited prior art. Claim 2 has a "receiving" step; claim 3 further limits the "establishing" step; etc. There has been no attempt by the Examiner to even acknowl-

edge the existence of these limitations. The rejection of claims 2-41 is respectfully traversed as being hopelessly inadequate.

Applicants wish to respectfully express their disappointment at the conduct of the examination of this application. The present application was filed, along with eight related companion applications, on January 27, 1997. Approximately 17 months later, all of the claims of this application and the eight related applications were rejected under 35 USC 112, second paragraph, for "multiplicity of claiming". On September 17, 1998 a telephonic interview was held at which time Examiner Trans agreed that these rejections were improper. See paper 4, mailed September 22, 1998. Furthermore, Examiner Trans promised in writing in paper 4:

Thus, the rejection dated June 26, 1998 is hereby withdrawn. The examiner will issue another Office Action within two weeks from the date of this letter.

On August 3, 1999, a first status inquiry was sent. No response. On November 16, 1999, a second status inquiry was sent. No response. After several telephone exchanges with the Examiner in January, 2000, the status was variously indicated as the "Application could not be found" and the "Office Actions would be remailed within a short stated period of time". Applicants' attorney, Mr. Johnson, again discussed the matter with Examiner Trans on January 20, 2000. At that time, Examiner Trans prom-

ised to check on the status of the alleged nine amendments and "re-mail" them.

When no amendments were received, Mr. Johnson again attempted to contact Examiner Trans. On February 11, 2000, Ms. Patrice Winder of Customer Service contacted Mr. Johnson. The pending Official Action (i.e., paper 5) was mailed February 23, 2000, along with amendments for the eight companion applications. The companion amendments seem to be of similar quality. Thus, Applicants are now about 40 months from the filing of these nine applications and do not yet have an official action which addresses the limitations of the claims.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-41 being the only pending claims.

Respectfully submitted,

Joseph P. Kerzman et al.

By their attorney,

Lawrence M. Nawrocki

Lawrence M. Nawrocki

Reg. No. 29,333

Suite 401

Broadway Place East

3433 Broadway Street N.E.

Minneapolis, Minnesota

55413

(612) 331-1464

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